



#13

PATENT APPLICATION

UNITED STATES DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE PATENT EXAMINATION BRANCH

In re Application of:

Humpleman et al.

Application No: 09/104,297

Filed: June 24, 1998

For Letters Patent on:

METHOD AND APPARATUS FOR A
HOME NETWORK AUTO-TREE BUILDER

Examiner: William Bashore

Art Unit: 2176

October 3, 2001
Los Angeles, California 90067

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Technology Center 2100

DECLARATION OF PRIOR INVENTION IN THE UNITED STATES OR IN A NAFTA OR WTO MEMBER COUNTRY TO OVERCOME CITED PATENT OR PUBLICATION (37 C.F.R. §§ 1.131)

1. This declaration is to establish completion of the invention in this application in the United States, at a date prior to June 13, 1997, that is the effective date of the prior art:

☒ publication

☐ patent

that was cited by the

☒ examiner.

☐ applicant.

NOTE: "When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102(a) or (e), or 35 U.S.C. 103 based on a U.S. patent to another or others which is prior art under 35 U.S.C. 102(a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in 37 C.F.R. 1.601(n), or on reference to a foreign patent or to a printed publication, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§§§ 1.42, 1.43 or 1.47, may submit an appropriate oath or declaration to overcome the patent or publication. The oath or declaration must include facts showing a completion of the invention

in this country or in a NAFTA or WTO member country before the filing date of the application on which the U.S. patent issued, or before the date of the foreign patent, or before the date of the printed publication. When an appropriate oath or declaration is made, the patent or publication cited shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent, unless the date of such patent or printed publication is more than one year prior to the date on which the inventor's or patent owner's application was filed in this country." 37 C.F.R. §§ 1.131(a)(1) .

NOTE: 37 C.F.R. §§ 1.131 is not applicable to a rejection based on a U.S. patent that CLAIMS the rejected invention.

2. The person making this declaration is (are):

☐ the inventor(s).

☒ only some of the joint inventor(s), and

☒ an authorized representative of the party in interest. The Assignment assigning the inventors' rights to the party-in-interest is recorded at Reel 9363, Frame 0766, recorded July 19, 1998. 37CFR 3.73(b). The inventors no longer work for Samsung Information Systems America, an affiliated company of Samsung Electronics, Ltd., the party-in-interest. However, Jeffrey P. Aiello, Reg. No. 39,086, is the Patent Manager of the party-in-interest, and can best testify to the facts surrounding the procedures involved in the constructive reduction to practice of inventions, and the preparation of invention disclosures and patent applications by employees and contractors for the party-in-interest.

FACTS AND DOCUMENTARY EVIDENCE

3.

To establish the date of completion of the invention of this application, the following attached document and/or models are submitted as evidence:

(check all applicable items below)

☒ A copy of United States Provisional Patent Application Serial No. 60/050,762 filed June 25, 1997, including twenty nine (29) pages of text, images, flow charts and software coding specifically expressing how to implement the claimed invention

☐ sketches

☐ blueprints

☐ photographs

☐ reproduction(s) of notebook entries

☐ model

☒ supporting statement(s) by witness(es). Since this application has multiple inventors and a corporate assignee, each of the inventors and the assignee's representative are considered to be corroborative witnesses.

(where verbal disclosures are the evidence relied upon)

NOTE: "The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application." 37 C.F.R. §§ 1.131(b).

NOTE: While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder* 1897 C.D. 724, 81 O.G. 1417." See also M.P.E.P. §§ 715.07 and §2138.04, 7th ed.

From these documents and/or models, it can be seen that the invention in this application was made

☐ on _____.

☒ at least before the date of June 10, 1997, which is a date earlier than the earliest possible asserted date of the reference. I have reviewed the attached Provisional Patent Application documents for USSN 60/050,762 filed June 25, 1997. These documents were signed by inventors Richard Humpleman and Kevin Harms on June 13, 1997, and by Robert Wolff and Michael Deacon on June 16, 1997. This is a 29 page document with extensive text, diagrams, flow charts, computer coding and other descriptions. This document was prepared in advance of June 10, 1997. The invention was conceived before June 10, 1997. The document evidences this because it was prepared after weeks, if not months of meetings and preparation of drafts for discussion prior to the final "Patent Disclosure" document being approved for Joint execution and filing. This document was then diligently circulated for execution and filing and then filed with the United States Patent and Trademark Office within two (2) weeks of execution.

NOTE: "If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration."

M.P.E.P. §§ 715.07 , 7th ed.

NOTE: "[T]he dates in the oath or declaration may be the actual dates, or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date."

M.P.E.P. §§ 715.07 , 7th ed.

DILIGENCE

NOTE: "Where there has not been reduction to practice prior to the date of the reference, the applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference continuously up to the date of the actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, §§ 1.131)." M.P.E.P. §§ 715.07, 6th ed., rev. 3 (emphasis added).

NOTE: "A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS HE OR SHE FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., Limited 1909 C.D. 498, 139 O.G. 991, M.P.E.P. §§ 715.07 , 7th ed.

"Conception in the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417, it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also." M.P.E.P. §§ 715.07 , 7th ed.

NOTE: Only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" (Ex parte Merz 74 U.S.P.Q. 296) is not relevant to an affidavit or declaration under 37 C.F.R. §§ 1.131 . M.P.E.P. §§ 715.07(a) , 7th ed.

Attached is a statement establishing the diligence of the applicants, from the time of their conception, to a time just prior to the date of the reference, up to the:

☐ actual reduction to practice.

☒ filing of this application.

TIME OF PRESENTATION OF THE DECLARATION

(complete (a), (b) or (c))

(a) ☐ This declaration is submitted prior to final rejection.

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10/03/01 03:29 FAX 3107893210

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(b) [] This declaration is submitted with the first response after final rejection, and is for the purpose of overcoming a new ground of rejection or requirement made in the final rejection.

(c) [X] This declaration is submitted after final rejection. A showing under 37 C.F.R. §§ 1.116(b) is submitted herewith.

DECLARATION

6. As a person signing below:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

SIGNATURE(S)

7.

(complete A or B below)

A. Inventor(s)

Full name of sole or first inventor: Richard Humpleman

Inventor's signature: _____

Date: _____

Residence: 345 Lower Vintners Circle, Fremont, California 94539

Citizenship: British

Post Office Address: Same as above

Full name of sole or second inventor: G. Kevin Harris

Inventor's signature: G. Kevin Harris

Date: 10/12/01

Residence: 5790 Barnswell Way, San Jose, California 95138

Citizenship: U.S.

Post Office Address: Same as above

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SIGNATURE(S)

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(complete A or B below)

A. Inventor(s)

Full name of sole or first inventor: Richard Humpleman

Inventor's signature: [Signature]

Date: 10/3/01

Residence: 343 Lower Vintners Circle, Fremont, California 94539

Citizenship: British

Post Office Address: Same as above

Full name of sole or second inventor: G. Kevin Harms

Inventor's signature: _____

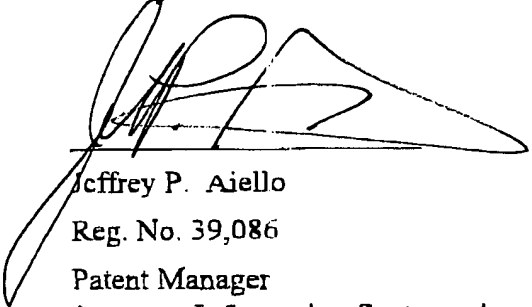
Date: _____

Residence: 5790 Barnswell Way, San Jose, California 95138

Citizenship: U.S.

Post Office Address: Same as above

B. Party-In-Interest



Jeffrey P. Aiello

Reg. No. 39,086

Patent Manager

Samsung Information Systems America

95 West Plumeria Drive

San Jose, California 95134

Date:

October 11, 2001

Assignment recorded in PTO on July 19, 1998.

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Inventor's signature:

Date:

Residence: 343 Lower Vintners Circle, Fremont, California 94539

Citizenship: British

Post Office Address: Same as above

Full name of sole or second inventor: G. Kevin Harms

Inventor's signature:

Date:

Residence: 5790 Barnswell Way, San Jose, California 95138

Citizenship: U.S.

Post Office Address: Same as above

B. Party-In-Interest

Date: _____

Jeffrey P. Aiello

Reg. No. 39,086

Patent Manager

Samsung Information Systems America

95 West Plumeria Drive

San Jose, California 95134

Assignment recorded in PTO on July 19, 1998.

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B. Party-In-Interest

Date: _____

Jeffrey P. Aiello

Reg. No. 39,086

Patent Manager

Samsung Information Systems America

95 West Plumeria Drive

San Jose, California 95134

Assignment recorded in PTO on July 19, 1998.

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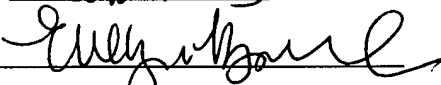
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CERTIFICATE OF MAILING BY "EXPRESS MAIL"

I hereby certify that this paper of fee is being deposited with the United States Postal Service on this date: 10/18/01, in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number EP501243865 addressed to: Box CPA, Commissioner for Patents and Trademarks, Washington, D.C. 20231

EVELYN MENJIVAR

(Type or print name of person mailing paper)


(Signature of person mailing paper)